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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/322,732 05/28/99 MAROTTI

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EXAMINER

SRIVASTAVA, D

ART UNIT

PAPER NUMBER

1653

8

DATE MAILED:

09/29/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/322,732

Applicant(s)

Marotti et al.

Examiner

Dev sh Srivastava, Ph.D.

Group Art Unit

1653

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-141 _____ is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-141 _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, 15-18 and 140-141, drawn to a method for identifying a compound which modulates the activity of prokaryotic elongation factor p (efp), classified in class 435, subclass 7.1 and class 435, subclass 7.5.
 - II. Claims 9-12, 15-20, 31-34, 39-42, 43, 44, 55-58, 63-66, 68, 79-82, 87-92, 123 and 133 drawn to a method for identifying a compound which modulates the activity of prokaryotic elongation factor p (efp) using a radiolabeled oxazolidine molecule, classified in class 435, subclass 7.1 and class 436, subclass 86.
 - III. Claims 13-14, 15-19, 21-30, 39-42, 45, 56-54, 61-66, 69-78, 85-91, 93 and 134-139 drawn to a method for identifying a compound which modulates the activity of prokaryotic elongation factor (efp) using RNA and/or ribosomal subunits, classified in class 436, subclass 94 and class 436 and subclass 86.
 - IV. Claims 35-38, 43, 59, 63-66, 83-84, 87-91, drawn to a method for identifying a compound which modulates the activity of prokaryotic elongation factor (efp) using radiolabeled efp, classified in class 435, subclass 7.9.
 - V. Claims 94-103, 114-117, drawn to a method for identifying a compound which modulates the activity of prokaryotic elongation factor (efp) using CACCA-radiolabeled amino acid, classified in class 435, subclass 6.

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- VI. Claims 104-108, 114-117, drawn to a method for identifying a compound which modulates the activity of prokaryotic elongation factor (efp) using a peptide bond donor, classified in class 436, subclass 86.
 - VII. Claims 109-117, drawn to a method for identifying a compound which inhibits the first peptide bond reaction of a complex formed through the interaction of efp, N-formylmethionyl-tRNA, 30S subunit, 50S subunit, an mRNA containing an AUG sequence, and initiation factors 1, 2, and 3 and a peptide bond donor, classified in class 436, subclass 86.
 - VIII. Claims 118-122, drawn to a method for identifying a compound which modulates the activity of prokaryotic elongation factor whereby the compound inhibits cell growth, classified in class 436, subclass 86.
 - IX. Claims 124-132, drawn to a method for identifying a compound which modulates the activity of prokaryotic elongation factor but not eukaryotic eIF5A, classified in class 436, subclass 94 and class 436, subclass 86.
2. The inventions are distinct, each from the other because of the following reasons:
3. The methods of Invention I-IX are unrelated each from the other. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are capable of use separate from each other, have different functions, different steps and different effects.

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4. Because these inventions are distinct for the reasons given above and the search required for Groups I-IX are not co-extensive, restriction for examination purposes as indicated is proper.

"For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02." (see MPEP 803). The serious burden of search has been established by the separate status in the art and different field of search for the inventions.

Further, the restriction groups have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the inventions is not co-extensive particularly with regard to the literature search. A reference which would anticipate the invention of one group would not necessarily anticipate or make obvious any of the other groups. Moreover, as to the question of burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. The literature search, particularly relevant in this art, is not co-extensive and is much more important in evaluating the burden of search. Burden in examining materially different groups having materially different issues also exist.

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

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named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Conclusion

7. Claims 1-141 are restricted.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devesh Srivastava, Ph.D. whose telephone number is (703) 305-0775. The examiner can normally be reached on Monday-Thursday from 8:00 am to 5:30 pm and alternate Fridays from 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, Ph.D., can be reached on (703) 308-2923. The FAX phone number for the Art Unit where this application or proceeding is assigned is (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

 Devesh Srivastava, Ph.D.
Patent Examiner
September 27, 2000


CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
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